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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,436	02/01/2005	Guenter Beyer-Meklenburg	103196-00008	1272

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EXAMINER

SPEER, TIMOTHY M

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/506,436

Applicant(s)

BEYER-MEKLENBURG ET AL.

Examiner

Timothy M. Speer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC §§ 102 and 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4, 10-12, 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kong for reasons of record in the Office Action dated 10/07/05.
3. Claims 5-7, 13-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kong for reasons of record in the Office Action dated 10/07/05.

Response to Arguments

4. Applicant's arguments filed 01/09/06 have been fully considered but they are not persuasive. As an initial matter, the Examiner notes that new claims 19 and 20 correspond to original claims 8 and 9, respectively.
5. With respect to the rejection of claims 1-4, 10-12, 17 and 20 (original claim 9) as being anticipated by Kong, applicant first argues that Kong fails to teach a "security document card," as presently claimed. In response to applicant's arguments, the recitation of a "security document card" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the present case, the portion of the claim following the preamble is directed to a multilayer film, such as that disclosed by Kong, and does not

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rely on the preamble for completeness. Accordingly, the preamble is not being given patentable weight and this argument is not persuasive.

6. With respect to claim 10, applicant asserts that the claimed recitation distinguishes over Kong because the recitation that "the coating comprises information engraved or written on by means of a laser" produces a structural feature that distinguishes over Kong. The "structural limitation" asserted by applicant is, by the plain meaning of the claim terms, simply writing. As such, this limitation does not patentably distinguish over Kong, since the writing is not functionally related to the product. Accordingly, the Examiner maintains the position set forth in the Office Action dated 10/07/05.

7. Finally, applicant argues that Kong fails to teach the use of hot melt adhesives, as recited in instant claim 12, teaching heat sealable blends instead. This argument is entirely without merit. Heat sealable blends adhere by melting on exposure to heat and, accordingly, read on the recited phrase, viz., hot melt adhesive.

8. Regarding the rejection of claims 5-7, 13-16, 18 and 19 (original claim 8) as being obvious in view of Kong, applicant argues that Kong teaches away from the thickness recited in claim 19, pointing to Kong at column 6, lines 28-33. This passage in Kong is directed to a preferred embodiment and in no way teaches away from other thicknesses. Moreover, this preferred embodiment is not limiting on the disclosure of Kong. Accordingly, the Examiner maintains the position set forth in the Office Action dated 10/07/05. Additionally, this argument is not persuasive with respect to claims 5-7, 13-16 and 18, since these claims do not recite the thickness limitation as recited in claim 19.

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9. In light of the above, applicant's arguments have been considered but are not found to be persuasive and the rejections set forth herein are maintained.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Timothy M. Speer



JENNIFER MCNEIL
PRIMARY EXAMINER
3/7/06